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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,236	08/14/2006	Tatsuo Ito	294372US2PCT	6963
22850 7590 09/15/2011 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER RUST, ERIC A				
ART UNIT 2625		PAPER NUMBER		
NOTIFICATION DATE 09/15/2011		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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# Office Action Summary

**Application No.**

10/589,236

**Applicant(s)**

ITO ET AL.

**Examiner**

ERIC A. RUST

**Art Unit**

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 January 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 5) ☒ Claim(s) 30-33 and 63-70 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 30-33 and 63-70 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-GB/US)  
Paper No(s)/Mail Date \_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 05, 2011 has been entered.

In the Amendment filed January 05, 2011, Applicants amended claims 30-33, canceled claims 15-29 and added claims 63-70. Accordingly, claims 30-33 and 63-70 are currently pending.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 63-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0160630 A1 to Iriyama et al. (hereinafter,

Iriyama) in view of U.S. Patent Application Publication No. 2003/0011633 A1 to Conley et al. (hereinafter, Conley).

**In regard to claims 63, 66, 67, and 70**, Iriyama discloses a system, comprising: an image forming apparatus (**Iriyama, Fig. 1, items 1 or 2**), including at least one of hardware resources of a scanner and a plotter (**Iriyama, [0056]**), that provides an image forming function for forming an image by using the at least one of the hardware resources as a Web service (**Iriyama, Abstract and [0051]**); and

an external processing apparatus (**Iriyama, Fig. 1, item 3**) configured to control the image forming function of the image forming apparatus by using the Web service provided by the image forming apparatus, wherein the image forming apparatus and the external processing apparatus are connected to each other through a network (**Iriyama, Fig. 1, item 4, and [0051]**),

a Web server of the external processing apparatus (**Iriyama, Fig. 1, item 1 or 2, and Fig. 5**) sends screen data of a user interface of the image forming function to a Web browser of the image forming apparatus in response to a screen update instruction sent from the Web browser of the image forming apparatus (**Iriyama, Fig. 5, [0051], and [0057]**);

the Web browser of the image forming apparatus displays the user interface of the image forming function at an operation part of the image forming apparatus by using the screen data of the user interface of the image forming function received from the Web server of the external processing apparatus (**Iriyama, Fig. 5, [0051], and [0057]**);

when a request with respect to the image forming function is received from the user interface of the image forming function displayed at the operation part of the image forming apparatus, the Web browser of the image forming apparatus sends a request to the Web server of the external processing apparatus (**Iriyama, Fig. 5, [0051], and [0057]**);

a Web service client of the external processing apparatus instructs an execution of the image forming function to a Web service server of the image forming apparatus based on the request from the Web browser of the image forming apparatus; and the Web service server executes the image forming function based on an instruction of the execution of the image forming function sent from the Web service client of the external processing apparatus (**Iriyama, Fig. 5, [0051], and [0057]**).

Iriyama does not disclose that the steps are done in response to a screen update instruction sent from the Web browser of the image forming apparatus.

Conley, however, discloses initializing (i.e., updating) a user interface (**Conley, [0038], lines 1-19**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Conley with the teachings of Iriyama in order to provide a novel method and system that is particularly adapted for and useful with document copiers and the like with embedded touch panel user interface displays for controlling the MFP functions and applications (**Conley, [0006]**).

**In further regard to claim 67**, the multiple image processing apparatuses are disclosed in Iriyama at, for example, Fig. 1, items 1 and 2.

**In regard to claims 64 and 68**, which depend from claims 63 and 67, respectively, the combination of Iriyama and Conley disclose wherein the Web service client of the external processing apparatus sends a request of the screen update instruction to the Web service server of the image forming apparatus (**Iriyama, Fig. 5, [0051], and [0057], and Conley, [0038], lines 1-19**);

the Web service server of the image forming apparatus sends a request of the screen update instruction to the Web browser of the image forming apparatus based on the request of the screen update instruction sent from the Web service client of the external processing apparatus (**Iriyama, Fig. 5, [0051], and [0057], and Conley, [0038], lines 1-19**); and

the Web browser of the image forming apparatus sends the screen update instruction to the Web server of the external processing apparatus based on the request of the screen update instruction sent from the Web service server of the image forming apparatus (**Iriyama, Fig. 5, [0051], and [0057], and Conley, [0038], lines 1-19**).

**In regard to claims 65 and 69**, which depend from claims 63 and 67, respectively, the combination of Iriyama and Conley disclose wherein a screen flow control part of the external processing apparatus generates the screen data of the user interface of the image forming function based on the screen update instruction, and

sends the screen data to the Web server of the external processing apparatus (**Iriyama, Fig. 5, [0051], and [0057], and Conley, [0038], lines 1-19**).

4. Claims 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iriyama and Conley in view of U.S. Patent Application Publication No. 2004/0239975 A1 to Kawaura et al. (hereinafter, Kawaura). Kawaura was cited in the IDS filed by Applicants on June 04, 2008.

**In regard to claim 30**, which depends from claim 63, neither Conley nor Iriyama disclose wherein, when the image forming apparatus and the external processing apparatus are in an offline state, the image forming apparatus reads out a file for building up the forming function from a storage area included in the image forming apparatus, builds up the image forming function in the image forming apparatus, and controls at least one of the hardware resources when a request is made to the image forming function built in the image handling apparatus.

Kawaura, however, discloses wherein when the image forming apparatus and the external processing apparatus are in an offline state, the image forming apparatus reads out a file for building up the forming function from a storage area included in the image forming apparatus, builds up the image forming function in the image forming apparatus, and controls at least one of the hardware resources when a request is made to the image forming function built in the image handling apparatus (**Kawaura, Abstract**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Kawaura with the teachings of Conley and Iriyama for when the image forming apparatus and the external processing apparatus are in an offline state, the image forming apparatus reads out a file for building up the forming function from a storage area included in the image forming apparatus, builds up the image forming function in the image forming apparatus, and controls at least one of the hardware resources when a request is made to the image forming function built in the image handling apparatus in order to improve the reliability of an update program (**Kawaura, [0019], lines 5-7**).

**In regard to claim 31**, which depends from claim 30, Kawaura discloses wherein, while the image forming apparatus and the external processing apparatus are in an online state, a file for building up the image forming function transferred from the external processing apparatus to the storage area (**Kawaura, Abstract**).

**In regard to claim 32**, which depends from claim 63, neither Conley nor Iriyama disclose wherein while the image forming apparatus and the external processing apparatus are in an offline state, at least a part of the user interface is transferred from the external processing apparatus to a storage area, and at least the part of the user interface is read out from the storage area.

Kawaura, however, discloses wherein while the image forming apparatus and the external processing apparatus are in an offline state, at least a part of the user interface



is transferred from the external processing apparatus to a storage area, and at least the part of the user interface is read out from the storage area (**Kawaura, Abstract**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Kawaura with the teachings of Conley and Iriyama for wherein while the image forming apparatus and the external processing apparatus are in an offline state, at least a part of the user interface is transferred from the external processing apparatus to a storage area, and at least the part of the user interface is read out from the storage area in order to improve the reliability of an update program (**Kawaura, [0019], lines 5-7**).

**In regard to claim 33**, which depends from claim 30, neither Kawaura, Conley, nor Iriyama specifically disclose wherein while the image forming apparatus and the external processing apparatus are in an online state, at least one of the hardware resources is controlled when a request is made to the external processing apparatus, and, while the image forming apparatus and the external processing apparatus are in the offline state, the at least one of the hardware resources is controlled when a request is made to the controlling part built in the image handling apparatus.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kawaura, Conley, and Iriyama so that while the image handling apparatus and the external processing apparatus are in an online state, the image formation unit is controlled when a request is made to the controlling part built in the external processing apparatus, and while the image handling apparatus and the

external processing apparatus are in an offline state, the image formation unit is controlled when a request is made to the controlling part built in the image handling apparatus in order to ensure that data processing is still completed even though the external processing apparatus is in an offline state.

### ***Response to Arguments***

5. Applicants' arguments with respect to claims 30-33 and 63-70 have been considered but are not persuasive.

**In regard to Applicants arguments with respect to the claim amendment,** Applicants argue that the claims have been amended and that none of the cited references disclose the receiving, displaying, sending, receiving, and executing steps of the claims. See Amendment, pg. 11.

The Examiner notes that the claims are newly added and have not been rejected or considered as a whole as of this Action. Moreover, Applicants' arguments, while appearing to be a bonafide response, are not specific enough to allow for the Examiner to answers them any more than has already been presented above in the current rejection.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC A. RUST whose telephone number is (571)-270-

3380. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benny Tieu can be reached on (571)-272-7490. The fax phone number for the organization where this application or proceeding is assigned is 571-270-4380.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ERIC A. RUST/

Examiner, Art Unit 2625

09/07/2011

/Benny Q Tieu/

Supervisory Patent Examiner, Art Unit 2625